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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/762,743

01/22/2004

Nicolas St.-Germain

13726

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7590

01/11/2005

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CHICAGO, IL 60604

EXAMINER

VY, HUNG T

ART UNIT

PAPER NUMBER

2821

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/762,743 | Applicant(s) ST.-GERMAIN, NICOLAS | |
| | Examiner Hung T Vy | Art Unit 2821 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledges

1. According to the rule USC 1.56 (Duty to disclose information material to patentability), the applicant request to provide the references for consideration. The rule U.S.C 1.56 as below:

1.56 Duty to disclose information material to patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §

§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) Prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

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- (2) It refutes, or is inconsistent with, a position the applicant takes in:
- (i) Opposing an argument of unpatentability relied on by the Office,
- or
- (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application;
 - (2) Each attorney or agent who prepares or prosecutes the application;
- and
- (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.
- (d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

[42 FR 5593, Jan. 28, 1977; paras. (d) & (e) - (i), 47 FR 21751, May 19, 1982, effective July 1, 1982; para. (c), 48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; paras. (b) and (j), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; paras. (d) and (h), 50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; para. (e), 53 FR 47808, Nov. 28, 1988, effective Jan. 1, 1989; 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (e) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Eckel et al., U.S. patent No. 6,388,399.

Claims 1,4-7,10-20, eckel et al. disclose an intelligent light emitting diode modulate for a traffic signal; comprising: a voltage source (70), said voltage source continuously supplying a voltage to said traffic signal (See column 10, line 23-31); an electronic switch (See column 2, line 17-29); an integrated flasher (See column 3, line 7 showing the light control unit to flash light); at least one light element (See fig. 14); a power supply (338) for powering the at least one light element (See fig. 14); a dimming interface for dimming the at least one light element (See fig. 11); a controller (340) for generating an appropriate command signal based on one or more status signals (see fig. 14), said status signals comprise one or more of the following: light element current, light element voltage, light output (450) (see fig. 18), input current and input voltage and said appropriate command comprise one or more of the following: an on or off command, a dimming command (See column 3, line 32-43), a flashing command, and an emergency disconnection signal; a light sensor (450) for detecting light output (See fig. 18) of the at least one light element; a voltage detecting circuit (62) for the light element voltage (See column 10, line 36-45), and the output voltage or combinations

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thereof; and a current monitoring circuit (See column 5, line 50-51) for measuring the light element current, the output current, or combinations thereof.

Claims 2-3, Eckel et al. disclose the light sensor is photocell (See fig. 20), one light element is an LED array (344)(See fig. 14).

Claims 8-9, it is inherent that Eckel et al. disclose an emergency disconnect because on column 10, line 31-35, Eckel et al. disclose a momentary contact switch the external power supply, this providing a reset function.

Response to Arguments

3. Applicant's arguments filed on 07/27/2003 have been fully considered but they are not persuasive. Applicant made the following arguments:

"Independent Claims 1 and 16 are traffic signals and not taught or suggested by Eckel. For example, claim 1 and 16 both include limitation that there is "a light sensor for detecting light output of the at least one light element(claim 1) or at least one LED array (claim 16). Eckel does not teach or suggest a traffic signal with all the limitations of the claims including a light sensor that monitors that lamp. The light sensor in Eckel does not monitor a lamp. It only monitors ambient light. Similarly, Eckel does not teach or suggest a traffic signal with all the limitation of the independent Claims including a voltage monitor that monitors light element voltage and a current monitor that monitors light

element current. Thus, the claims are not taught or suggested by Eckel. " page 6 fifth paragraph and first paragraph, page 7.

In response to Applicant's argument above, the applicant's argument are not persuasive because the claims recite only switch, flasher, power supply, a light sensor, voltage detecting circuit and a current monitoring circuit without any recitation of limitations of structure to define an intelligent light emitting diode module for a traffic signal. Eckel discloses all limitation of claims as switch, flasher, power supply, a light sensor, voltage detecting circuit and a current monitoring circuit (See rejection above). Further, Eckel teaches the light sensor 156 (fig. 6) for detecting light output of the at least one light element 154. On fig. 7, Eckel teaches the light sensor 214. Ambient light sensor is sensor light from the light source. Furthermore, Eckel discloses a voltage detecting circuit the light element voltage and a current monitoring circuit for measuring the light element current as in column 5, line 50-63 mentions the ability to monitor "monitor changes in power, current or voltage and to determine if **lamps have been burned out.**" So Eckel discloses the voltage, current detecting circuit for detecting the light element voltage in order to monitor if lamps have been burned out. Thus, Eckel taught all limitation of claims.

The Examiner requests the applicant's response the acknowledges on rejection 1 above (Duty to disclose information material to patentability).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

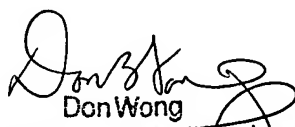
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Vy whose telephone number is (571) 272-1954. The examiner can normally be reached on Monday-Friday 8:30 am - 5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Hung T. Vy
Art Unit 2821
January 8, 2005.


Don Wong
Supervisory Patent Examiner
Technology Center 2800